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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92067668
Party	Plaintiff TAJMA Enterprises
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Attachments	BEESBUTTER MTN AND RESPONSE 7.25.18.pdf(3237351 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF Trademark Registration No. 5,368,804
For the mark BEESBUTTER

TAJMA ENTERPRISES, LLC,	)	
Petitioner,	)	
v.	)	**Cancellation No. 92067668**
Rubrecht, Shaun M,	)	
Respondent.	)	

PETITIONER'S MOTION FOR LEAVE TO WITHDRAW AND REPLACE ADMISSIONS AND OPPOSITION TO RESPONDENT'S MOTION FOR SUMMARY JUDGMENT

TAJMA Enterprises, LLC ("Petitioner"), through counsel, hereby submits this Motion for Leave to Withdraw and Replace Admissions and Opposition to Shaun Rubrecht's ("Respondent's") Motion for Summary Judgment. In support thereof, Petitioner respectfully submits the arguments and facts set forth below.

MOTION FOR LEAVE TO WITHDRAW AND REPLACE ADMISSIONS

Petitioner requests the Board for leave to withdraw any admissions deemed admitted and replace them with Petitioner's responses to Respondent's requests for admission. (*See* attached Exhibit 1.) In his motion for summary judgment, Respondent argues that a delay in replying to requests for admission has produced a result that the requests "automatically stand admitted." (D. Mtn. Sum. J. at 3.) This argument is the basis for the forty "uncontested facts" upon which Respondent bases his motion for summary judgment. (*Id.* at 3-7.) However, as of the date of this filing, Petitioner has served Answers to Requests for Admission on Respondent's counsel.

Indeed, as of the date of this filing, Petitioner has provided responses to all of the discovery propounded by Respondent. (*See* attached Exhibit 2.)

As an initial matter, any delay was inadvertent. The delay in providing responses to Respondent's requests for admission was canvassed with Respondent well in advance of the date the requests were served: Respondent was informed that Petitioner might face an unavoidable delay in discovery due to a significant move that could impair Petitioner's communicability. (*See* attached Exhibit 3; Exhibit 2.) Petitioner's counsel was under the impression (mistaken though it was) that the parties understood and accepted the impact these circumstances could have on the discovery process. (*See* attached Exhibit 3; Exhibit 2.) Petitioner reiterated these circumstances and this understanding to Respondent in a letter dated June 11, 2018, to which Petitioner received no reply. (*See* attached Exhibit 3; Exhibit 2.)

The answers provided by Petitioner deny all of Respondent's primary allegations. (*See* attached Exhibits 1-2.) There was never any question that this matter involves issues of disputed fact. Indeed, in discussions between counsel, Petitioner's counsel has repeatedly informed Respondent's counsel that Petitioner "has every intention of continuing the opposition proceeding" in accordance with its pleadings. (*See* attached Exhibit 3).

If Petitioner is deemed to have admitted the material in Respondent's requests for admission, any such admission was inadvertent and due to a good faith mistake on Petitioner's part regarding an understanding between the parties. Accordingly, Petitioner requests that such admissions be deemed withdrawn and amended by Petitioner's response to Respondent's requests for admission. (*See* attached Exhibit 1.)

Federal Rule of Civil Procedure 36(b) provides a two-prong test for withdrawal and amendment of admissions when (1) it would promote presentation of the merits of the action and

(2) the party who obtained the admissions will not be prejudiced in maintaining or defending an action on the merits. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks, Inc*., 85 U.S.P.Q.2d 1306, 1309 (TTAB 2007). Here, Petitioner has already submitted a response to Respondent's requests in which all of the facts relied on by Respondent in its motion for summary judgment are denied, thereby demonstrating that the matters are dispute. (*See* attached Exhibit 1, denying that Respondent first conceived of the idea for a leather conditioner (Request 4), denying that Respondent first used the BEESBUTTER mark (Request 5), and denying that Respondent first affixed the mark to the goods (Request 8), among other material denials.)

As to Rule 36(b)'s second prong, Respondent will not be prejudiced by allowing withdrawal of Petitioner's possible admissions and replacement with the later-served responses. Indeed, Respondent has received Petitioner's responses while this case is still in the pre-trial stage, discovery is still open, and any potential prejudice can be mitigated by extending the discovery period. Here, Respondent faces no particular prejudice, and indeed, no burden other than the existent burden of defending a cancellation proceeding. *Giersch*, 85 U.S.P.Q.2d 1306, 1309 (finding reliance on admissions in filing motion for summary judgment does not rise to level of prejudice contemplated by Fed. R. Civ. P. 36(b)). Accordingly, Petitioner requests an order of the Board withdrawing any deemed admissions and deeming Petitioner's answers to have been timely filed.[1]

[1] Because Petitioner's response to the requests for admission which expressly denies the Respondent's allegations, the "Undisputed Facts" listed by Respondent are in fact very much in dispute. (D. Mtn. Sum. J. at 3-7.)

OPPOSITION TO RESPONDENT'S MOTION FOR SUMMARY JUDGMENT

The allegations raised in Respondent's motion for summary judgment are inaccurate, and the motion accordingly must be denied. Respondent's motion can be distilled into three simple allegations:

1. The allegation that there exist no issues of material fact with respect to Petitioner's claim of likelihood of confusion. (D. Mtn. Sum. J. at 17-18);
2. The allegation that there exist no issues of material fact with respect to Petitioner's claim of fraud in the procurement. (*Id.* at 13-17); and
3. The allegation that there exist no issues of material fact with respect to Respondent's asserted defenses of licensee estoppel, waiver, and unclean hands. (*Id.* at 7-12.)

Petitioner has expressly denied the admissions upon which Respondent's motion is based. (*See* attached Exhibit 1.) As these denials suggest, there exist genuine issues of disputed fact between the parties such that a motion for summary judgment is inappropriate. Among these contested issues of fact are questions regarding ownership of the BEESBUTTER mark, the import of a Memorandum of Understanding ("MOU") between the parties, Respondent's intent in filing for the BEESBUTTER application, and the impact of Petitioner's use of another trademark (AGED LEATHER PROS).

Summary judgment is only appropriate when there is no genuine dispute as to any material fact. *See* Fed. R. Civ. P. 56(a); *LinkedIn Corp. v. International Council for Education Reform and Development (ICERD)*, 2018 WL 529851 (TTAB Jan. 19, 2018). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1987).

In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant – in this case Petitioner – and all justifiable inferences are to be

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